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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,424	02/19/2002	Roger Tipple	22122	3375

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EXAMINER

FLANDRO, RYAN M

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 04/16/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/069,424

Applicant(s)

TIPPLE, ROGER

Examiner

Ryan M Flandro

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9 and 10 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

## DETAILED ACTION

### *Claim Objections*

1. Claim 6 is objected to because of the following informalities: recitation of the limitation “or the like” in line 3 of the claim should be removed. Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 7, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips (US 327,717) in view of Novoplast GmbH (CH 482,087) (Novoplast).
  - a. Claim 1. Phillips shows and discloses a fencing system including a plurality of pales **A**, at least one horizontal rail **B**, and fastening means **b**; each pale **A** having a generally concave or re-entrant external surface facing the rail **B**, the fastening means **b** engaging the said surface so as to fasten the pale **A** to the rail **B** (see figure 2; column 1). Phillips lacks, however, disclosure that the pale is tubular. Tubular fence posts are well known in the art as taught by Novoplast (see figure 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made modify the post of Phillips to make it tubular in order to reduce the weight of the post as taught by Novoplast.

- b. Claim 2. The combination of Phillips and Novoplast further includes the concave or re-entrant surface defines a space between the pale **A** and the rail **B**, and the fastening means **b** pass through the space, such that the fastening means **b** draw the concave or re-entrant surface towards the rail **B** to as to press the wall resiliently against the rail **B** (see figure 2; column 1).
- c. Claim 3. Phillips further shows the pale **A** including a generally convex outer surface facing away from the rail **B**.
- d. Claim 4. Phillips further shows the concave or re-entrant surface includes a flat central portion, and the fastening means **b** engage therewith (see figure 2).
- e. Claim 5. Phillips also shows the concave or re-entrant surface includes a thickened portion, and the fastening means **b** engaged therewith (figure 2).
- f. Claim 7. The combination of Phillips and Novoplast, as applied to claim 1 above, includes a pale **A** having a generally crescent hollow cross-section, the cross section including rounded regions where the concave or re-entrant surface meets the convex surface, the rounded regions abutting the rail **B**.
- g. Claim 9. The combination of Phillips and Novoplast, as set forth above, would include a method of erecting a fencing system comprising the steps of fixing the rail **B** horizontally in its intended final position, and fastening the pales **A** to the rail **B**. Under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device

described in the specification, it can be assumed the device will inherently perform the same process. *In re King*, 802 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986).

h. Claim 10. The combination of Phillips and Novoplast, as applied in claim 1, includes a tubular (see Novoplast) pale **A** having a generally concave or re-entrant external surface facing the rail **B**, the fastening means **b** engaging the said surface so as to fasten the pale **A** to the rail **B** (see Phillips figure 2; column 1).

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Phillips and Novoplast, as applied to claim 1 above, further in view of Kreusel (DE 29611017). The combination of Phillips and Novoplast includes the fastening means **b** comprise a bolt (see Phillips), but lacks disclosure that the concave or re-entrant surface further includes a threaded hole, and that the fastener engages in the threaded hole. Kreusel, however, teaches a pale **1** having a threaded hole **5a,5b** intended to be engaged by a fastener **6** in order to secure the post to a rail without protruding hardware such as nuts (see figure 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made modify the pale of Phillips by providing a threaded hole in a wall thereof in order to secure the pale to a rail without external hardware such as nuts as taught by Kreusel.

*Allowable Subject Matter*

5. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. The following is a statement of reasons for the indication of allowable subject matter: The prior art, including Phillips, Novoplast, and Kreusel, either alone or in combination, fails to disclose or teach a pale having longitudinal indentations, the indentations inducing buckling of the pale when the pale is subjected to a predetermined force, and the force being less than that required to break the fastening means and so detach the pale from the rail.

### *Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art with respect to fencing systems and tubular pales:

U.S. Patent 5,581,868 to Bisch (see especially figures 11 and 12)

U.S. Patent 5,529,289 to Lancer, Sr. (see figures 8A and 8B)

U.S. Patent 4,599,843 to Ingvarsson (notes strength advantages of profile)

U.S. Patent 4,123,183 to Ryan (longitudinal indentations for strength purposes)

U.S. Patent 4,015,826 to Lauzier

U.S. Patent 3,524,627 to Boyanton


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan M Flandro whose telephone number is (703) 305-6952.

The examiner can normally be reached on 8:30am - 5:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H Browne can be reached on (703) 308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Ryan M. Flandro  
April 11, 2003



**Lynne H. Browne**  
***Supervisory Patent Examiner***  
**Technology Center 3670**